

REMARKS

Claims 1-31 are pending in this application. Claims 1, 10, 16, 17, 27 and 31 are independent claims. No claims are amended and no claims are canceled in the foregoing amendment. Reconsideration and allowance of the present application are respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a) – Vanghi in view of Li

Claims 1-3, 5, 6, 8-24, and 26-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,937,861 to Vanghi (hereinafter "Vanghi") in view of U.S. Patent 6,269,402 to Lin et al. (hereinafter "Lin"). Applicants respectfully traverse this rejection, as detailed below.

MPEP 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, the recently published "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", (hereinafter "KSR Guidelines") further supports the basic requirement for a finding of obviousness as clearly articulated in the following.

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-3, 5, 6, 8-24, and 26-31 are improper because the elements for a *prima facie* case of obviousness are not met.

i) The References do not Teach or Suggest All the Features of the Claimed Invention

The rejection fails to meet the criterion that the prior art must teach or suggest all the claims’ limitations or as stated in the KSR Guidelines “a finding that the prior art included each element claimed”. Each of Applicants’ independent claims 1, 10, 16, 17, 27 and 31 recite, in part, features such as *“transmitting a pause command to the first wireless network.”* Applicants respectfully assert that Vanghi and Lin, either alone or in combination, fail to teach or suggest at least this feature of independent claims 1, 16, 17, 24 and 31.

Initially, Applicants agree with the Examiner that Vanghi does not reach the above quoted feature of the independent claims. However, Applicants disagree with the Examiner’s assertion that this feature is taught in Lin.

Lin is directed to transitioning communication between a client and a server from a first bearer network to a second bearer network. Lin teaches establishing a first communication session between a client and a server over a first bearer network, the packets using a first envelope identifier. At some time later, the first connection is suspended/terminated, and a second connection is initiated between the same client and server on a second bearer network, the packets now using a second envelope identifier. After the second connection is established, a session transition control block is used to map messages or packets received after the suspension/transition to the second connection with a second envelope identifier.

In the rejection, the Examiner notes:

The first connection is terminated in response to a suspension request transmitted between network entities (see fig.5, step 512; col.5, lines 55-62) such as between the client 102 and the server 104 (see col.5, lines 15-30). After the interruption has occurred, (at fig.5; step 516, col.6, lines 12-20), the connection may resume by issuing a resume command over the second bearer network. (See pg. 3, second para., of the Office Action).

As the Examiner correctly notes, the first connection is terminated in response to the suspension request. The ‘suspension’ effectively queues data at the server until it can be sent using a second connection yet to be established. Accordingly, Applicants submit that the suspension request of Lin pointed to by the Examiner is not equivalent to the claimed pause command. The suspension request of Lin permanently terminates the first connection over the first bearer link. In contrast to the claimed invention, Lin merely describes transitioning between a first and second link connecting the same client and server, not pausing one link that is later resumed. In Lin, the suspended link is never resumed. Resuming communications in Lin is done through the second bearer link, not the first bearer link. Thus, there is no ‘pause’ of a first communication in the sense that it will later be resumed (as in the claimed invention), but merely a termination of the first link in favor of a second link.

Therefore, Applicants submit that Lin fails to teach or suggest *“transmit[ing] [a] pause command to the first wireless network”* as recited in independent claims 1, 10, 16, 17, 27 and 31.

ii) There is not Sufficient Suggestion or Motivation to Modify the References

Secondly, the rejection fails to meet the *prima facie* obviousness criterion that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

As described above, Lin teaches terminating a first connection in favor of a second connection. As pointed out by the Examiner, a suspension request sent by a network entity effectively terminates that connection. In contrast, Vanghi teaches momentarily suspending communication with a first radio network, so that it can briefly communicate with a second radio network, then resuming communication with the first radio network. Thus, if the teachings of Lin were applied to those of Vanghi as in the proposed modification by the Examiner, Vanghi would actually terminate the first radio network connection before briefly communicating with the second radio network. Vanghi would therefore be rendered unsatisfactory for its intended purpose of thereafter continuing communication with the first radio network without having to completely re-establish such a connection. It is a well known tenet of U.S. patent law that if a proposed modification would render the reference's invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), see also MPEP § 2143.01.

Furthermore, the principle of operation of the connection management invention disclosed in Vanghi is to control access to network resources based on whether access terminal 14 has or has not exceeded the maximum allowed period of activity as determined by a fade timer. If no fade timer is initiated, as would presumably be the case under the proposed modification where a pause command would be issued, access terminal 14 would not be able to track the fade timer, and the fade timer tracking techniques of the invention described in Vanghi would be rendered unsatisfactory for their intended purpose. As noted above, if a proposed modification would render the reference's invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Moreover, if the fade timer tracking techniques underlying the principle of operation of Vanghi were ignored, and instead, a pause/resume command signal principle of operation

employed as proposed by the Examiner, the proposed modification would change the principle of operation of Vanghi. It is also a well known tenet of U.S. patent law that if the proposed modification of a reference would change the principle of operation of the reference's invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), *see also* MPEP § 2143.01. See also, the KSR Guidelines, referenced above, requiring that “each element merely would have performed the same function as it did separately.”

Accordingly, Vanghi in view of Lin cannot render as obvious, under 35 U.S.C. § 103, Applicants' invention as presently claimed in independent claims 1, 10, 16, 17, 27 and 31. The nonobviousness of independent claims 1, 10, 16, 17, 27 and 31 also precludes the rejections of claims 2, 3, 5, 6, 8, 9, 11-15, 18-24, 26, and 28-30, which depend variously therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. See In re Fine, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 1-3, 5, 6, 8-24, and 26-31.

Claim Rejections under 35 U.S.C. § 103(a) – Vanghi in view of Rajaniemi

Claims 4, 7 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vanghi in view of Lin, and in further view of U.S. Patent 6,487,399 to Rajaniemi et al. (hereinafter “Rajaniemi”). Applicants respectfully traverse this rejection, as detailed below.

Rajaniemi fails to cure the deficiencies of Vanghi and Lin discussed above with regard to independent claims 1 and 17. Thus, Applicants submit that the nonobviousness of independent claims 1 and 17 precludes a rejection of claims 4, 7, and 25 depending therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. See In re Fine, 5, USPQ.2d 1596, 1600 (Fed Cir. 1988), *see also* MPEP § 2143.03.

Therefore, the Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to dependent claims 4, 7, and 25.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: May 8, 2008

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